

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE DIRECTOR

In re Application Avi J. Ashkenazi et al.)
Serial No. 09/894,924)
Filed: June 28, 2001)
_____)

Decision on Request
under 37 C.F.R. § 1.304(a)(3)(ii)

MEMORANDUM AND ORDER

Patent applicants Avi J. Ashkenazi et al. (Ashkenazi) filed a request under 37 C.F.R. § 1.304(a)(3)(ii) for an extension of time to file a Notice of Appeal in application serial number 09/894,924. When an appeal is taken to the Court of Appeals for the Federal Circuit, the appellant must file the Notice of Appeal both with the Court and the Director. *See* 37 C.F.R. §§ 1.301, 1.302(a). The time for filing Ashkenazi's Notice of Appeal expired on January 13, 2006. Ashkenazi correctly filed his Notice of Appeal with the Federal Circuit on January 13th, but failed to file the required Notice with the Director by that date.

On January 18, 2006, Ashkenazi filed a Request for Extension of Time under 37 C.F.R. § 1.304(a)(3)(ii) for filing the Notice with the Director, asking that time be extended to January 18, 2006. A copy of the January 13, 2006 Notice was attached. However, due to typographical errors in the Request called to Ashkenazi's attention by an attorney in my Office, Ashkenazi filed a Corrected Request for Extension of Time on January 25, 2006, seeking an extension to January 18th. The Request is granted.

When an applicant seeks an extension of time to file his Notice of Appeal after the expiration of the relevant filing period, the Director may extend the time "upon a showing that the failure to act was the result of excusable neglect." 37 C.F.R. § 1.304(a)(3)(ii). In determining excusable neglect, the PTO applies the standard used by the Federal Courts. MPEP

§ 1216. The determination of what kinds of neglect are excusable is “an equitable one, taking account of all relevant circumstances surrounding the party’s omission. These include . . . the danger of prejudice to [another party], the length of the delay and its potential impact on judicial proceedings, the reason for the delay, including whether it was within the reasonable control of the movant, and whether the movant acted in good faith.” *Pioneer Inv. Servs. v. Brunswick Assocs. Ltd. P’ship*, 507 U.S. 380, 395 (1993).

Ashkenazi states that he did attempt to file the Notice of Appeal with the Director on January 13, 2006, but inadvertently sent that Notice to the Federal Circuit. Ashkenazi says that the Express Mail form “illustrates the Appellant’s excusable neglect in that the address inserted into the form is that of the Federal Circuit, not the Director.” The Express Mail form shows the error, not why the error is excusable. Mere carelessness or inattention on the part of counsel is not *per se* excusable neglect. *Williams v. The Five Platters, Inc.*, 510 F.2d 963, 964 (CCPA 1975).

Further, the Rules are clear that “[n]otices of appeal directed to the Director shall be mailed to or served by hand on the General Counsel as provided in § 104.2.” 37 C.F.R. § 1.302(e). Rule 104.2 clearly states what address should be used in filing the Notice with the Director. *See* 37 C.F.R. § 104.2. Here, the copy of the Notice intended for the Director provided by Ashkenazi indicates that Ashkenazi was not using the correct address. Thus, even if Ashkenazi had not erroneously sent the copy intended for the Director to the Federal Circuit, it would not have been properly filed with the PTO.

However, we note that the address appearing in MPEP §§ 1216 and 1216.01 for filing a Notice of Appeal with the Director appears to be inconsistent with the address provided at 37

C.F.R. § 104.2. MPEP § 1216.01 indicates that when filing a Notice of Appeal, an applicant should use the “P.O. Box 1450” address and not “P.O. Box 15667.” Conversely, Rule 104.2 lists the “P.O. Box 15667” address for use in filing appeal notices. Because he attempted to use the address provided by the MPEP, Ashkenazi appears to have made a good faith effort to file the Notice with the Director.¹ Ashkenazi also sent a courtesy copy of the appeal to the Board of Patent Appeals and Interferences on January 13, 2006, further evincing his good faith.

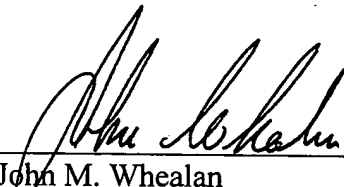
Ashkenazi’s carelessness in filing his Request for an Extension of Time raises additional concerns. The first Request, filed on January 13, 2006, contained several typographic errors including an incorrect application number and inaccurate statement of the named inventors. That resulted in delay at the Office and necessitated that Ashkenazi file a Corrected Request on January 26, 2006. Additionally, while typographical errors will understandably happen, they are less understandable when made in an attempt to remedy previous errors of the same type.

However, applying the *Pioneer* factors to this situation ultimately weighs in favor of Ashkenazi. Here, there is no danger of prejudice to another party. The length of delay was not long and will have no impact on judicial proceedings. Although the errors appear to have been the result of mere carelessness or inattention and under Ashkenazi’s reasonable control, the evidence of Ashkenazi’s good faith outweighs those facts. Specifically, use of the address for filing the Notice with the Director as provided by the MPEP and service of a courtesy copy with the Board (which was then provided to the Solicitor’s Office) suggest that Ashkenazi acted in good faith to comply with 37 C.F.R. § 1.301. Thus, the error in addressing the Express Mail

¹Of course, in case of conflict between a C.F.R. provision and the MPEP, the Rules control.

forms was an illustration of "excusable neglect." Further, the typographical errors relating to Ashkenazi's first Request for an Extension of Time were not an issue because he addressed them soon after they occurred. On consideration of these factors, the Request will be granted. The time for filing the Notice of Appeal is extended to January 18, 2006. Further, Ashkenazi's Notice will be deemed filed with the Director on January 18, 2006, per its inclusion with the Request for an Extension of Time filed that day.

Applicants, interested parties, and their counsel should be aware that similar instances of carelessness in the future will not be as favorably considered.



John M. Whealan
Deputy General Counsel for
Intellectual Property Law and Solicitor

2/6/06

cc: Jeffrey P. Kushan, Esq.
Sidley Austin, LLP
1501 K Street, N.W.
Washington, D.C. 20005